

REMARKS

Claims 1-14 have been examined. With this amendment, Applicant adds claims 15-28. Claims 1-28 are all the claims pending in the application. The Examiner has rejected claims 1-14.

I. Formalities

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority and for confirming that the certified copy of the priority document has been received. However, the Examiner did not check the box under section 12.a.1 on the front cover sheet of the Office Action. Applicant requests that the Examiner check this box in the next Office Action.

Applicant thanks the Examiner for initialing and returning a copy of the form PTO-1449 submitted with the Information Disclosure Statement filed on October 12, 2000.

II. Specification

The Examiner has objected to the disclosure of the invention because of a minor typographical error. Applicant has corrected this minor error. Applicant requests that the objection to the specification be withdrawn.

III. Drawings

The Examiner has objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: 110C is mentioned on page 23, line 26 and 110K on page 23, line 27, but do not appear in Figure 8.

Applicant has corrected Figure 8 to show the reference signs "110C" and "110K." Applicant requests that the objection to the drawings be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-5 and 7-13 under 35 U.S.C. § 102(e) as being anticipated by Fujisawa (US 6,384,932) [“Fujisawa”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites an apparatus for outputting an image that comprises a “preparing means for preparing a plurality of gradation conversion curves whose gradation characteristics are different stepwise from each other.” The Examiner contends that the claimed “stepwise” difference is implied by the selection made by the user.

Fujisawa discloses a plurality of tone curves, based on a use purpose, that previously exist (col. 19, lines 4-6). There is no disclose or suggestion in the reference that the curves are “stepwise” different from each other as set forth in claim 1.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference ... Inherency, however, may not be established by probabilities or possibilities.” MPEP at page 2100-52. Applicants submit the Examiner’s contention that “stepwise” difference is implied by the selection made by the user does not make clear that the missing descriptive matter is necessarily present.

Further, the selection made by a user, which the Examiner contends corresponds to the “stepwise” difference, cannot correspond to an element of an apparatus claim. See *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993).

In addition, the Examiner’s comments indicate that no distinction is made between gradation characteristics that are “different stepwise” and just different. Applicant submits that

“stepwise” would indicate that the claimed curves vary in steps. The Examiner has not provided any analysis that would correspond to the claimed feature. In addition, a mere difference in curves would not indicate “stepwise” since logarithmic curves and lineal curves would generally be considered different, but not considered “stepwise” different when compared to each other.

Because claim 9 recites features similar to claim 1, Applicant submits that claim 9 is patentable for at least reasons similar to those given above with respect to claim 1.

Applicant submits that claims 2-5, 7, 8 and 10-13 are patentable at least by virtue of their respective dependencies.

In addition, claim 7 recites an apparatus that comprises a correcting means for newly generating...curves.” Fujisawa discloses curves that previously exist and are stored in a storage device (col. 19, lines 4-7). There is no disclosure or suggestion in Fujisawa of “newly generated” curves as set forth in claim 7.

V. Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Fujisawa in view of Lee (US 5,541,028) [“Lee”]. For at least the following reason, Applicant traverses the rejection.

The Examiner concedes that Fujisawa does not disclose the claimed curves as set forth in claims 6 and 14 but applies Lee to allegedly cure the deficiency. The Examiner contends that it would have been obvious to combine the references because a process that is adaptable to film can “easily and at once” be adapted to any application that employs an exposure process.

“The mere fact that references can be combined or modified does not render the resultant combination obviousness unless the prior art also suggests the desirability of the combination.”
MPEP at page 2100-131.

In the present case, the invention in Lee is directed to optimizing tone scales for diagnostic radiography and relates to film or film-screen (col. 1, lines 5-9). There is no disclosure or suggestion of an application to plate making process. Fujisawa relates to a digital impositioning apparatus using a file output of electronic data instead of film output (Abstract).

Applicant submits that the Examiner’s reason for combining, which appears to be mere speculation about film exposure technology, does not provide an objective reason to combine as required by the MPEP since there is no support in the prior art for the Examiner’s bald assertion. And the Examiner’s speculation does not provide evidence in the record as required by *Zurko*. See *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Because one skilled in the art would not have combined the references as suggested by the Examiner, Applicant submits that claims 6 and 14 are patentable at least by virtue of their respective dependencies.

VI. New Claims

With this amendment, Applicant adds claims 15-28. Applicant submits that because independent claim 15 recites features similar to those given above with respect to claim 1, claim 15 is patentable for at least reasons similar to those given above with respect to claim 1. Applicant submits that the remaining claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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